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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/836,870 | 04/17/2001 | Claude Jarkae Jensen | 10209.166 | 5882 |
| 21999 | 7590 | 11/04/2004 | EXAMINER | |
| KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120 | | | YU, GINA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,870

Applicant(s)

JENSEN ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 9, 2004 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 4-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (JP 200095663A, machine translation) in view of Gidlund (US 6436449 B2) and Duffy et al. (US 5472699).

Kondo teaches that it is well known in cosmetic art to use an extract of *Morinda citrifolia*. The reference teaches a cosmetic composition comprising plant extracts which provide skin whitening, oxygen scavenging and/or antimicrobial effect. *Morinda Citrifolia* (noni) is among the plant extracts disclosed in the reference. See translation, paragraphs [0001- -0009]. Kondo further teaches the invention may be formulated into various types of cosmetic compositions, including skin care lotion and face toilet, which is considered as a skin toner product. See translation, paragraph [0017]. The whitening effect of Mulberry bark extract (which is deemed to be noni) is also discussed

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in paragraphs [0025-36] and Table 2. The reference further teaches that the cosmetic compositions may include the additives that meet instant claims 19-26. The reference teaches also using astringent. See paragraph [0020]. These ingredients meet the “a balancing toner ingredient” and “a hydrating toner ingredient” limitation in instant claim 1.

While the cosmetic formulation in Kondo contains 4.8 % of *Morinda Citrifolia* (noni), differences in concentration in general will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Kondo, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Increasing the concentration of noni would be desirable to enhance the whitening, antioxidant, and antibacterial effect of the composition.

The example composition in Kondo contains the bark extract of noni and it fails to teach processed *Morinda Citrifolia* fruit juice.

Gidlund teaches using the extract from *Morinda citrifolia* derived from the roots, the bark, and leaves or the fruits using extraction techniques well-known to the persons skilled in the art or described in the literature. See col. 4, lines 19 – 25. The reference teaches that the extract from the fruits may be either liquid, i.e., the juice as pressed from the fruits and treated in the way conventional to the art, or solid, i.e., dry, e.g. as a powder, e.g. as obtained by processing as described in U.S. Pat. No. 5,288,491 to Moniz. See col. 4, lines 26 – 30. The Gidlund patent is directed to method of treating

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tinnitus by administering to a person suffering from tinnitus extract from *Morinda citrifolia*, wherein the medicament may be in the form for oral rectal, inhalation or transdermal administration. See col. 3, line 60 – col. 4, line 15. The reference teaches that it is well known in the art that the fruit of *Morinda citrifolia* has antibacterial activity. See col. 1, lines 38 – 41. The reference further teaches that xeronine in the *Morinda citrifolia* fruit is the active ingredient in treating numerous symptoms and ailment. See col. 2, lines 21 – 54. Examiner takes the position that the recited “release of xeronine” in claims 1 and 2 necessarily takes place in the topical application of noni fruit juice or the in the juice itself.

Duffy teaches an aqueous cosmetic composition comprising botanical astringent comprising extracts from Witch Hazel, Linden which is a source of vitamin C, E, and farnesol, and St. John’s Wort which is a source of vitamin A. Employing silica, water, ethyl alcohol (denatured alcohol), glycerin (a humectant), pyridoxine HCL, fragrances, thickeners, preservatives, and colorants are also disclosed. See col. 4, line 36 – col. 6, line 34. The reference teaches that the invention helps reduce the size of pore of the skin and control sebum secretion. See col. 2, lines 18 – 52.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of the Kondo by adding processed *Morinda citrifolia* noni fruit juice as motivated by Gidlund because 1) Kondo teaches of using noni extract in cosmetic composition for whitening and antibacterial effects; 2) Gidlund teaches of topical use of extract of noni fruit, root, bark or leaves, and the antibacterial activity of the fruit extract and the release of xeronine therefrom; 3)

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and the skilled artisan would have had a reasonable expectation of successfully producing a topical composition which provide enhanced antibacterial effect and beneficial effect of the activity of xeronine. The skilled artisan would have been further motivated to looked to prior arts such as Duffy for specific additive components suitable for botanical astringents and modified the composition of Kondo by incorporating such additives because of the expectation of successfully producing a skin care composition that improves skin appearance by whitening the skin, reducing the pore size and controlling oil secretion, and/or provides antiseptic effect. The method of topically applying the said composition to hydrate and balance pH of the skin would have been an obvious use of the combined toner composition comprising an astringent and humectant.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4-28 have been considered but are moot in view of the new ground(s) of rejection in part and unpersuasive in part.

Applicants' arguments regarding the rejections made under 35 U.S.C. § 112, first and second paragraphs are moot in view of the withdrawal of the rejection.

In response to applicants' arguments that "one of ordinary skill in the art would recognize that different ingredients often perform different functions or have different effects" is unpersuasive and lacks factual supports. Examiner respectfully notes that, in the contrary to applicants' argument, it is well known in pharmaceutical art the extracts derived from the fruits, the leaves, the bark or the roots of *Morinda citrifolia* have been

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used in treatment of tinnitus. See Gidlund (US 2001/0033871 A1), abstract. Examiner views that the Gidlund reference suggests that extracts from different parts of the plant can be indistinguishably used.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, while applicants assert that the references are "complete within themselves", the argument is an attack against individual references. The obviousness of modifying the Kondo composition as proposed by the examiner must be construed in view of the collective teachings of the all cited references.

Conclusion

No claims are allowed.

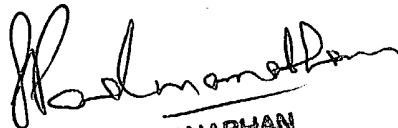
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina C. Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER